## REMARKS/ARGUMENTS

**Claims 1, 2 and 4-6** are pending in the application. **Claims 3 and 7** have been cancelled.

In the Office Action of January 24, 2005:

1. **Disclosure** is objected to because of the following informalities: in numbered paragraph [0001], line 2, June 6 should be – June 5 – and the status of the parent applications should be updated;
2. The IDS submitted 10/31/03 has been considered by the Examiner, and the **IDS submitted 10/20/03** has been considered by the Examiner to the extent indicated, in regards to the documents not considered by the Examiner no copies of documents were found in the parents or supplied with the instant information disclosure statement.
3. **Claims 1-6** are rejected under 35 USC 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
4. **Claims 1-4, 6 and 7** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 17, 43 of U.S. Patent No. 6,424,885, as well as over claims 9, 18 and 38 of U.S. Patent No. 6,424,885;
5. **Claims 1-4, 6 and 7** are rejected under 35 USC 103(a) as being unpatentable over **Green** 5,808,665 (the "Green '665 patent") in view of **Green** 5,631,973 (the "Green '973 patent"), and further in view of **Nose et al.** 5,053,976 (the "Nose et al. patent");

### 1. Objection to the Disclosure

Numbered paragraph [0001] has been amended so that "Jun. 6, 2002" has been changed to – Jun. 5, 2002 -- and the status of the parent applications updated, so that the objection to the disclosure is believed to be overcome.

### 2. IDS submitted 10/20/03

A supplemental information disclosure will be submitted in a separate communication including the documents identified in, but not included with, the IDS submitted 10/20/03.

3. **Rejection of Claims 1-6 under 35 USC 112, 2nd Paragraph**

Claim 1 has been amended to: replace "the slave arm" with – the slave – (in the "processor" paragraph) which has antecedent basis (in the "slave" paragraph); replace "a workspace" with -- a surgical workspace – (in the "slave" paragraph) so as to clarify which workspace is being referred to as well as provide antecedent basis for "the surgical workspace" (in the "processor" paragraph); add "a tool" (in the "slave" paragraph) to provide antecedent basis for "the tool" (in the "processor" paragraph); and delete "the holder" (in the "processor" paragraph), thereby making it unnecessary to provide antecedent basis for it; and with such amendments, Claim 1 is believed to be patentable under 35 USC 112, 2nd paragraph.

Claim 5 has been amended to delete original lines 2-4, and with such amendment, Claim 5 is believed to be patentable 35 USC 112, 2nd paragraph.

Claim 6 has been amended to: provide proper antecedent basis for "the group"; and replace "the camera" with – the image capture device -- which has antecedent basis in Claim 1, and with such amendments, Claim 6 is believed to be patentable under 35 USC 112, 2nd paragraph.

4. **Rejection of Claims 1-4, 6 and 7 under judicially created doctrine of obviousness-type double patenting**

A Terminal Disclaimer to Obviate a Double Patenting Rejection over a Prior Patent (i.e., commonly owned U.S. Patent No. 6,424,885) has been executed by the assignee, and is being submitted herewith along with the required payment for the Statutory Disclaimer fee.

5. Rejection of Claims 1-4, 6 and 7 under 35 USC 103(a)

Claim 1 has been amended to incorporate the limitations of Claim 3, and Claims 3 and 7 have been cancelled.

As amended, Claim 1 claims a surgical robotic system in which the input device can move in the controller workspace with a first number of degrees of freedom, and the end effector can move in the surgical workspace with a second number of degrees of freedom, wherein the second number is less than the first number.

None of the cited references, i.e., the Green '665 patent, the Green '973 patent, or the Nose et al. patent, alone or in combination, teaches or suggests such a surgical robotic system.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As for Claim 1, the limitation of an input device moving in a controller workspace with a first number of degrees of freedom and an end effector moving in a surgical workspace with a second number of degrees of freedom, wherein the second number is less than the first number, is believed not to be taught in any of the cited Green or Nose et al. references.

Further, there appears to be no suggestion by or in any of the cited Green or Nose et al. references of this limitation. The citing of a potential benefit gained by the limitation, where that benefit is neither taught nor suggested in the references, followed by a

declaration that the addition of the limitation to a structure disclosed in one or more of the references would have been obvious to one of ordinary skill in the art because of such a benefit, is believed to be nothing more than inappropriate hindsight reasoning.

Accordingly, amended Claim 1 is believed to be patentable under 35 USC 103(a) over the Green '665 patent in view of the Green '973 patent, and further in view of the Nose et al. patent for the foregoing reasons.

Claims 2 and 4-6 are also believed to be patentable under 35 USC 103(a) over the Green '665 patent in view of the Green '973 patent, and further in view of the Nose et al. patent, since they depend from Claim 1, and as such, are believed to be patentable for at least the same reasons as stated above in reference to Claim 1.

Claims 1-2 and 4-6 are pending in the application. Reconsideration of the rejected pending claims is respectfully requested, and an early notice of their allowance earnestly solicited.

Respectfully submitted,

Dated: 5-23-05

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